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10/578,378	05/05/2006	Declan Patrick Kelly	CN 030047	6604

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EXAMINER	
KIM, EDWARD J	

ART UNIT	PAPER NUMBER
2455	

MAIL DATE	DELIVERY MODE
12/08/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/578,378	KELLY ET AL.	
	Examiner	Art Unit	
	EDWARD J. KIM	2455	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 July 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1, 2, 6-8, and 11-17* is/are pending in the application.

4a) Of the above claim(s) *3-5 and 9-10* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,6-8 and 11-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is in response to the Amendment filed on 07/14/2009.

2. Claims 1, 2, 6-8, and 11-17 are pending. Claims 3-5 and 9-10 have been cancelled.

Response to Amendment

3. The Examiner withdraws previous 35 USC 112 rejections.

Response to Arguments

4. Applicant's arguments filed on 07/14/2009 have been fully considered but they are not persuasive.

The Applicant argues,

"The characterization of Kanazawa is respectfully traversed."

In response:

The Examiner points out that as explained in the 35 USC 112 rejections below, at least the terms "the abnormal playing status" and "the information which is required after the abnormal playing status ends" are indefinite to what exactly is being referred to. As explained, given the broadest reasonable interpretation, the abnormal playing status encompasses broad terminology, including the additional content accessed as disclosed by Kanzawa (Kanazawa, col.2 ln.20-25, col.5 ln.18-34, col.6 ln.55-67, col.5 ln.46-54, col.12 ln.55-65. Kanazawa discloses the use of external resources on a computer network.) (Kanazawa, fig.8, fi.g9, fig.15, fig.19, col.7 ln.50-col.10 ln.45). Kanazawa discloses wherein the system detects that the user has accessed additional information, for example, at least when the user presses the WEB button

to access additional information, which are referenced by the media and accessed by the system via searching relevant URLs (Kanazawa, fig.8, fi.g9, fig.15, fig.19, col.7 ln.50-col.10 ln.45). It is when this additional information is accessed (therefore putting the system in abnormal playing status, wherein the abnormal playing status is a status playing additional information, which stops media playback, as suggested by the Applicant in the specification, refer to 35 USC 112 rejections below), that the system downloads the additional information and meanwhile, stops the media playback while playing the additional information. The media playback is continued after the additional information is over.

Also, given another interpretation of the claim language, abnormal playing status may also refer to the status of the system prior to playback of the media, for example, when the DVD is inserted but before playback of the media. In such case, systems that pre-load additional information referenced by URLs before playback reads on the claim language. Examples of prior arts are those referenced in the "International Search Report" (EP 1267352 A, EP 1122729) provided by the Applicant, which is part of the "Documents submitted with 371 Applications" field on 05/05/2006.

Given the broadest reasonable interpretation of the claim language, in view of the indefinite terms as explained in the following 35 USC 112 rejections, the invention as claimed by still reads on the prior arts of record.

Claim Objections

5. Claim 1 is objected to because of the following informalities:

Claim 1 recites, "...to download information that is required while the player is playing and is not in the abnormal playing status…". There is some grammatical confusion as to whether the downloading is performed while the player is playing or the download information is required for the player to play. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 7 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 7 and 11 recite "only when the abnormal playing status is detected". Support for the system performing the steps "only" when the abnormal playing status is detected cannot be found.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 6 recite "the abnormal playing status", which is described in the Specification as including "pause status, copyright information status (some text information used by copyright warning) and director annotation (some explanatory words used by director annotation), and the like" (refer to pg.5 ln.3-5 of the Specification of the Application filed 05/05/2006). The scope of "abnormal playing status" limitation, which seems to be the core part of the invention, cannot be determined in view of the Specification of the Application. Therefore, claim 1 is vague and indefinite to what the limitation is, failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention.

The disclosure defines the above term as pause status, copyright information status, director annotation *and the like.* These seem to suggest that any kind of interruption or operation performed during playing of data is considered to be an abnormal playing status. The metes and bounds of the term are vague and indefinite. Pause status may be an operation carried out by a user or any interruption caused by the system, such as jitter due to bandwidth issues, etc., wherein the Applicant is trying to solve such jitter.

The metes and bounds of an abnormal playing status cannot be determined as explained above. Accordingly, metes and bounds of a normal playing status cannot be determined. The disclosure seems to suggest a normal playing status is one that plays the data without any interruption or any kind of operation performed such as pausing.

Similarly, claims 1 and 6 recite "the information which is required after the abnormal playing status ends", which is not described in the Specification in detail to determine the scope of the feature, failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. No clear definition of the phrase can be found. It is the

Examiner's understanding from the specification that the invention seeks to download additional data/information, referenced by URLs, which is in addition to the data stored on the optical disc. As the claim language stands, the quoted phrase above may refer to the actual data/information to be viewed by the user, which is already stored in the optical disc, which renders the claim language to be indefinite to what is exactly being claimed as the invention.

Claims 1 and 6 recite "wherein *content* required when the abnormal playing ends is downloaded prior to…". There is nor reference to "content" prior to the quoted phrase, rendering the claim indefinite, since it cannot be clearly determined whether this "*content* required" is different from the "*information* required", which was referenced earlier on in the claims.

The Applicant has the right to be a lexicographer, however, in this case, the metes and bounds of the terms cannot be clearly defined, rendering the claim language indefinite to what is exactly being claimed. Further clarification is required in the claim language or the specification.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1, 2, 6, and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Kanazawa et al. (US Patent #6,580,870 B1), hereinafter referred to as Kanazawa.

Kanazawa discloses a system for reproducing AV information from a recording medium, which utilizes other external resources on a computer network that is referenced via URL (Kanazawa, Abastract).

Regarding claim 1, Kanazawa discloses, an optical disc player (Kanazawa, Abstract, col.1 ln.20-25, col.1 ln.57-67), comprising: a detecting module for detecting whether the player is in an abnormal playing status or is not in the abnormal playing status (Kanazawa, fig.8, fi.g9, fig.15, fig.19, col.5 ln.10-34, col.6 ln.54-60, col.8 ln.10-20), and sending a searching command in response to detecting the abnormal playing status (Kanazawa, fig.8, fi.g9, fig.15, fig.19, col.7 ln.50-col.10 ln.45;

a searching module for searching a URL list stored on an optical disc in response to the search command to identify a URL in the URL list which provides a link to information which is required after the abnormal playing status ends, but which has not yet been downloaded; and (Kanazawa, fig.8, fi.g9, fig.15, fig.19, col.2 ln.20-25, col.5 ln.18-34, col.6 ln.55-67, col.5 ln.46-54, col.12 ln.55-65. Kanazawa discloses the use of external resources on a computer network.) (Kanazawa, fig.8, fi.g9, fig.15, fig.19, col.7 ln.50-col.10 ln.45);

a network management apparatus for accessing one or more URLs identified by the search module in response to detecting that the player is in the abnormal playing status, to download information that is required while the player is playing and is not in the abnormal playing status, wherein content required when the abnormal playing ends is downloaded prior to the abnormal playing status ending such that playing is not interrupted (Kanazawa, fig.8, fi.g9,

fig.15, fig.19, col.5 ln.18-34, col.6 ln.55-67, col.5 ln.46-54.) (Kanazawa, fig.8, fi.g9, fig.15, fig.19, col.7 ln.50-col.10 ln.45).

Regarding claim 2, Kanazawa disclosed the limitations, as described in claim 1, and further discloses, a storage for storing the downloaded information (Kanazawa, col.5 ln.10-34, col.6 ln.43-50. Kanazawa discloses downloading external information from web pages or on a computer network it is connected to.).

Regarding claim 6, Kanazawa discloses, a playing method of optical disc, comprising acts of: detecting whether an abnormal playing status of a player is currently occurring or whether the player is currently playing and is not in the abnormal playing status (Kanazawa, fig.8, fi.g9, fig.15, fig.19, col.7 ln.50-col.10 ln.45);

in response to detecting that the abnormal playing status of the player is currently occurring, searching a URL list stored on an optical disc to identify a URL in the URL list which provides a link to information which has not yet been downloaded and (Kanazawa, col.2 ln.20-25, col.5 ln.18-34, col.6 ln.55-67, col.5 ln.46-54, col.12 ln.55-65. Kanazawa discloses the use of external resources on a computer network.) (Kanazawa, fig.8, fi.g9, fig.15, fig.19, col.7 ln.50-col.10 ln.45);

in response to detecting that the abnormal playing status of the player is currently occurring, accessing one or more URLs identified by the searching to download the information which is required after the abnormal playing status ends, wherein content required when the abnormal playing ends is downloaded prior to the abnormal playing status ending such that playing is not interrupted (Kanazawa, col.2 ln.20-25, col.5 ln.18-34, col.6 ln.55-67, col.5 ln.46-

54, col.12 ln.55-65, col.6 ln.43-50. Kanazawa discloses downloading external information from web pages or on a computer network it is connected to.) (Kanazawa, col.7 ln.50-col.10 ln.50).

Regarding claim 8, Kanazawa disclosed the limitations, as described in claim 6, and further discloses, further comprising an act of storing the downloaded information for subsequent access and use (Kanazawa, col.5 ln.10-34, col.6 ln.43-50.).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. Claims 7, and 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanazawa et al. (US Patent #6,580,870 B1), hereinafter referred to as Kanazawa.

Regarding claim 7, Kanazawa disclosed the limitations, as described in claim 6. Kanzawa fails to explicitly disclose wherein the act of searching includes searching the URL of the information which is not yet downloaded only when the abnormal playing status is detected. Kanazawa discloses downloading when an abnormal status is detected, therefore, it would have been obvious to one of ordinary skill in the art to modify the teachings of Kanazawa to limit the downloading only to when abnormal status is detected (Kanazawa, col.5 ln.46-54, col.6 ln.43-50, col.2 ln.20-25, col.5 ln.18-34, col.6 ln.55-67, col.5 ln.46-54, col.12 ln.55-65.). One would have been motivated to do so to further limit Kanazawa's teachings.

Regarding claim 11, Kanazawa disclosed the limitations, as described in claim 1, however, fails to explicitly disclose, wherein the searching module is configured to only search when the abnormal playing status is detected. Kanazawa discloses downloading when an abnormal status is detected, therefore, it would have been obvious to one of ordinary skill in the art to modify the teachings of Kanazawa to limit the downloading only to when abnormal status is detected (Kanazawa, col.5 ln.46-54, col.6 ln.43-50, col.2 ln.20-25, col.5 ln.18-34, col.6 ln.55-67, col.5 ln.46-54, col.12 ln.55-65.). One would have been motivated to do so to further limit Kanazawa's teachings.

Regarding claim 12, Kanazawa disclosed the limitations, as described in claim 1, however, fails to explicitly disclose wherein the abnormal playing status includes a pause status of the player. Kanzawa discloses wherein the download of certain information pauses the playback, therefore it would have been obvious to one of ordinary skill in the art to modify the teachings to downloading during a pause (Kanazawa, col.5 ln.46-54, col.6 ln.43-50, col.2 ln.20-25, col.5 ln.18-34, col.6 ln.55-67, col.5 ln.46-54, col.12 ln.55-65.).

Regarding claim 13, Kanazawa disclosed the limitations, as described in claim 1, however fails to explicitly disclose wherein the abnormal playing status includes when director annotation information is being provided by the player. Kanzawa discloses the information is downloaded when the user accesses additional information (Kanazawa, fig.8, fi.g9, fig.15, fig.19, col.7 ln.50-col.10 ln.45, col.5 ln.46-54, col.6 ln.43-50, col.2 ln.20-25, col.5 ln.18-34, col.6 ln.55-67, col.5 ln.46-54, col.12 ln.55-65.). It would have been obvious to one of ordinary skill in the art to modify the additional information to be director annotation.

Regarding claim 14, Kanazawa disclosed the limitations, as described in claim 1, however, fails to explicitly disclose abnormal playing status includes when copyright information is being provided by the player. Kanzawa discloses the information is downloaded when the user accesses additional information (Kanazawa, fig.8, fi.g9, fig.15, fig.19, col.7 ln.50-col.10 ln.45, col.5 ln.46-54, col.6 ln.43-50, col.2 ln.20-25, col.5 ln.18-34, col.6 ln.55-67, col.5 ln.46-54, col.12 ln.55-65.). It would have been obvious to one of ordinary skill in the art to modify the additional information to be copyright information.

Regarding claim 15, Kanazawa disclosed the limitations, as described in claim 6, however, fails to explicitly disclose wherein the abnormal playing status includes a pause status of the player. Kanzawa discloses wherein the download of certain information pauses the playback, therefore it would have been obvious to one of ordinary skill in the art to modify the teachings to downloading during a pause (Kanazawa, col.5 ln.46-54, col.6 ln.43-50, col.2 ln.20-25, col.5 ln.18-34, col.6 ln.55-67, col.5 ln.46-54, col.12 ln.55-65.).

Regarding claim 16, Kanazawa disclosed the limitations, as described in claim 1, however fails to explicitly disclose wherein the abnormal playing status includes when director annotation information is being provided by the player. Kanzawa discloses the information is downloaded when the user accesses additional information (Kanazawa, fig.8, fi.g9, fig.15, fig.19, col.7 ln.50-col.10 ln.45, col.5 ln.46-54, col.6 ln.43-50, col.2 ln.20-25, col.5 ln.18-34, col.6 ln.55-67, col.5 ln.46-54, col.12 ln.55-65.). It would have been obvious to one of ordinary skill in the art to modify the additional information to be director annotation.

Regarding claim 17, Kanazawa disclosed the limitations, as described in claim 1, however, fails to explicitly disclose abnormal playing status includes when copyright

information is being provided by the player. Kanzawa discloses the information is downloaded when the user accesses additional information (Kanazawa, fig.8, fi.g9, fig.15, fig.19, col.7 ln.50-col.10 ln.45, col.5 ln.46-54, col.6 ln.43-50, col.2 ln.20-25, col.5 ln.18-34, col.6 ln.55-67, col.5 ln.46-54, col.12 ln.55-65.). It would have been obvious to one of ordinary skill in the art to modify the additional information to be copyright information.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWARD J. KIM whose telephone number is (571)270-3228. The examiner can normally be reached on Monday - Friday 7:30am - 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571) 272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Edward J Kim/
Examiner, Art Unit 2455

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